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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,298	01/29/2001	Herve Cunin	G-74	8603
21839	7590	06/01/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			STEVENS, THOMAS H	
POST OFFICE BOX 1404				
ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
			2123	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/772,298	CUNIN, HERVE
	Examiner Thomas H. Stevens	Art Unit 2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 January 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 January 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Claims 1-4 were reviewed for prosecution.

Abstract

2. The abstract of the disclosure is objected to because PCSC and EMV should be spelled out. Correction is required. See MPEP § 608.01(b).

Drawings

3. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Cases 1 and 3 are missing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 10/10/000. It is noted, however, that applicant has not filed a certified copy of the 00/13340 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The application does not define what case 2 and 4 are. Furthermore, case 1 and 3 are missing.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Revision of this claim is requested because of the confusing intermixing of subcategories denoted as (b), (b'), etc., coupled with back-to-back preambles.

9. Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are cases 1 and 3.

Claim Interpretation

10. Office personnel are to give claims their "**broadest reasonable interpretation**" in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d

1023, 1027-28 (Fed. Cir. 1997). Limitations are not appearing in the specification nor are they recited in the claims. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551(CCPA 1969). See *also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322(Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow") The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process. **The examiner interprets the claims as a emulation of the normal transactions of Smart Cards.**

Claim Rejections - 35 USC § 103

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4 are rejected under 35 U.S.C. 103 (a) as unpatentable by Levie et al. (U.S. Patent 6,065,675 (2000)) in view of Bakker-B (" Mutual Authentication with Smart Cards" (1999)).

Levie et al. teaches a modular terminal apparatus, which has a plurality of interchangeable communication modules (abstract) that includes emulation interface (column 31, lines 37-43), which are EMV and ISO 7816 compatible (column 29, lines 11-17 and 25-30); but doesn't detail the emulation process.

Bakker teaches a design of a new three party authentication and key distribution protocol to serve as a foundation for www-based transactions (abstract), coupled with a smart card process which is emulated via ISO-7816 standards (pg 10, section 3.3 and pg. 9. 3.2).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to use Levie et al. to modify Bakker since it would have advantageous to conduct such an experiment by linking a monitoring device to the emulator to visualize the entire process while initiating the necessary changes for optimization.

Claim 1. A method of emulating a chip card reader functioning according to the PSCS standard in order to manage a chip card reader functioning according to the EMV

standard and communicating with the chip card according to the protocol T= 0, comprising the following steps (Levie: column 29, lines 10-17) (a) determining the types of APDU exchanges for which emulation is to be effect; (b) emulating the return of a state word in compliance with the standards of the PCSC environment; (c) when the type of APDU exchange corresponds to a Case 2 as defined in ISO 7816-4, receive the command C-APDU complying with the state word; (d) when the type of APDU exchange corresponds to a case 4 as defined in the standards, receiving the command GET-REPONSE using the state word; (e) returning R-APDU in response to C-APDU or to GET-RESNNSE (Levie: column 31, lines 37-43; Bakker: pg.3, section 1.2; pg. 7, figure 1; and pg.3.1, 1st paragraph with bullets 1-4).

Claim 2. A method according to Claim 1, wherein the operations (c) and (d) are in reverse order (Levie: column 31, lines 37-43; 7, figure 1; and pg.3.1, 1st paragraph with bullets 1-4).

Claim 3. A method according to Claim 1(Levie: column 31, lines 37-43; 7, figure 1; and pg.3.1, 1st paragraph with bullets 1-4), wherein the operation (c) is followed by the following step: (c₁) emulating the return of a state word, complying with the standards of the PCSC environment as provided for when the type of APDU exchange corresponds to a case 4.

Claim 4. A method according to Claim 1(Levie: column 31, lines 37-43; 7, figure 1; and pg.3.1, 1st paragraph with bullets 1-4), wherein the operation comprises the following operations (b') and (b'') and operation (d') operation: (b') emulating an alarm state, which can relate to the application of the chip card, and sending to the PCSC environment the state word complying with the standards, (d') receiving the command GET-RESPONSE parameterized such that the number of bytes awaited is 0, (b'') emulating a state word, complying with the standards, to the PCSC environment as provided for when the type of APDU exchange corresponds to Case 4 (Levie: column 29, lines 10-17; Bakker: pg. 10, section 3.3).

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Stevens whose telephone number is (703) 305-0365, Monday-Friday (8:30 am- 5:30 pm) or contact Supervisor Mr. Kevin Teska at (703) 305-9704. The fax number for the group is 703-872-9306.

Any inquires of general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (703) 305-3900.

May 25 2004

THS



KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER